

U.S. Patent Application No. 09/147,362
Attorney Docket No. P63163US0

Remarks/Arguments:

Claims 55 and 65, presented hereby in place of claims 44-54, are pending in the subject application.

Present claim 55 corresponds to claim 44 revised by deleting "of the monomer type" from line 1 of the claim and by making changes as a matter of form, as explained below. Claim 58 corresponds to claim 47 revised by adding "said peptide being freeze-dried or diluted in water" at the end of the claim, support for which can be found in the specification at page 18, lines 21-23, page 27, lines 2-3, and page 31, lines 20-21. Claim 64 corresponds to claim 53 revised to include *first and second containers*, and 65 corresponds to claim 54 revised to include *first and second containers*, as further explained below. Present claims 56, 57, and 59-63 correspond to claims 45, 46, and 48-52, respectively, revised to be directly or indirectly dependent on (new) claim 55.

Accordingly, present claims 55-65 correspond to claims 44-54, respectively, revised as explained in the immediately preceding paragraph.

According to the instant Office Action, the synthetic peptides of claims 44-54 constitute subject matter found to be free of the prior art and would be allowable if amended as suggested therein. Applicants wish to thank the examiner for the timely indication of allowable subject matter and for helpfully suggesting the claim amendments, which render the claims allowable. As further explained below, present claims 55-65 incorporate most of the examiner's suggestions. Applicants submit that the changes reflected in claims 55-65, presented hereby, taken in conjunction with the instant remarks, render claims 55-65 allowable.

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The objection to claim 47, as being an improper dependent claim, is resolved by the instant amendment. Present claim 58, which replaces claim 47, contains the added limitation "said peptide being freeze-dried or diluted in water," as indicated above. In that the added limitation is not found in claim 55, on which claim 58 is dependent, claim 58 further limits the subject matter of claim 55 and, so, is a proper dependent claim.

The amendment to claim 44 as represented by present claim 58, discussed above, also resolves and overcomes the objection maintaining that claims "51/52 and 53/54" appear to be substantial duplicates. That is, claim 58 contains a limitation not found in claim 55; and, therefore, claims 63 and 65, being dependent on claim 58, contain limitations not found in claims 62-64, which are dependent on claim 55. In other words, present claim 63, which replaces claim 52, is not a substantial duplicate of claim 62, which replaces claim 51; and, present claim 65, which replaces claim 54, is not a substantial duplicate of present claim 64, which replaces claim 53.

Claims 44-54 were rejected under 35 USC 112, second paragraph, as allegedly being indefinite. Reconsideration is requested in view of the instant amendment.

By the instant amendment, the language "monomer type" recited in claim 44, considered "confusing" according to the statement of rejection, does not appear in the present claims. As explained above, claim 44 is amended by deleting "of the monomer type," as reflected in present, replacement claim 55.

The statement of rejection, further, alleges that "correction [of claim 44] to clearly set forth the salient structural characteristics of the claimed peptides is required," and corresponding changes

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to claim language are suggested (Office Action, paragraph bridging pages 2 and 3). In connection with this allegation, and the suggestions that follow it, the statement of rejection fails to provide the requisite support for the "correction" allegedly "required," i.e., there is neither explanation as to how the claim language is supposedly indefinite nor, even, identification of any (allegedly) indefinite claim language.

As such, other than identifying "monomer type" as allegedly confusing language, there is nothing in the statement of rejection to support the rejection of record under §112, ¶2. Accordingly, since none of the pending claims recites "monomer type," the rejection of record under §112, ¶2, as applied to claim 44 is completely overcome, i.e., the rejection under §112, ¶2, of record can be neither applied nor sustained against pending claim 55, or any other pending claim.

Notwithstanding the foregoing remarks in connection with the rejection of claim 44 under §112, ¶2, the some of the suggested changes set forth in the statement of rejection, after appropriate modification, have been incorporated into present (replacement) claim 55. As incorporated into claim 55, none of these (modified) changes reflects any substantive change to claim 44, in any way, but only relate to matters of form.

In connection with analyzing claim 44 (or any claim) for compliance with §112, ¶2, it must be remembered that it is applicants' sole prerogative to define the claims, *In re Wilkington*, 162 USPQ 145, 148 (CCPA 1969), and compliance does not require that the claims be defined conventionally. *In re Castaing*, 166 USPQ 550 (CCPA 1970) (a parent applicant is entitled to be his own "lexicographer"). Furthermore, merely that it requires some thought to understand the

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meaning of a claim does not render the claim indefinite under §112, ¶2. *S3 Inc. v. BiVIDIA Corp.*, 59 USPQ2d 1745, 1748 (Fed. Cir. 2001).

In connection with the rejection under §112, ¶2, as applied against claims 53 and 54, the changes in claim language set forth in the statement of rejection, in order to overcome the rejection, have been adopted. As indicated above, replacement claims 64 and 65, which correspond to rejected claims 53 and 54, respectively, include limitations to *first and second containers*, i.e., claim 64 recites

a) a first container comprising at least one synthetic peptide of formula (I) according to claim 55 and b) a second container comprising appropriate means of detection of complexes between said antibodies and said peptide

and claim 65 recites

a) a first container comprising a composition according to claim 58 and b) a second container comprising appropriate means of detection of complexes between said antibodies and said peptide.

In view of the aforesaid language (changes) recited in claims 64 and 65, the rejection of claims 53 and 54 under §112, ¶2, is overcome.

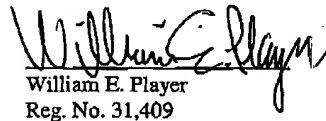
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Favorable action is requested.

Respectfully submitted,

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